PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number
	Q92872

Mail Stop AF	Application Number	Filed
Commissioner for Patents	10/566,705	February 1, 2006
P.O. Box 1450 Alexandria, VA 22313-1450	First Named Inventor	
	Akira ICHIKAWA	
	Art Unit	Examiner
	2123	Eunhee KIM

WASHINGTON DC SUGHRUE/265550

65565

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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

  Note: No more than five (5) pages may be provided.

☑ I am an attorney or agent of record.

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/Logan J. Brown 58,290/

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January 11, 2007

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	Docket No: Q92872
Akira ICHIKAWA, et al.	
Appln. No.: 10/566,705	Group Art Unit: 2123
Confirmation No.: 8042	Examiner: Eunhee KIM
Filed: February 1, 2006	

For: AUTOMATED DESIGN SYSTEM, AUTOMATED DESIGN METHOD AND AUTOMATED DESIGN PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the

Examiner's Final Office Action dated July 12, 2007, Applicant files this Pre-Appeal Brief

Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

The Examiner has rejected claims 1-9 under 35 U.S.C. § 102(b) as allegedly being

anticipated by Li (USP 6,915,252).

Claim 1 relates to a automated design system for performing automated design of a

product, and recites, *inter alia*:

> **automated design means for performing**
> **automated design using** design requirement
> particulars with respect to a design of the
> product required by a customer or a

designer, **designer discretion particulars by discretion of the designer with respect to the design of the product,** and the design rule necessary with respect to the design of the product,

. . .

design result determination means for determining whether a **design result** obtained by the automated design means **satisfies the determination rule** . . .

Applicant would like to draw the Examiners' attention to the clear error in the Examiner's rejection with regard to each of the above recited claim requirements and with regard to the rejection in general.

In the previous office action, the Examiner asserted that Li teaches "designer discretion particulars" in the teaching of the "physical design" in Column 10, Lines 46-55. (Office Action, P. 5). In the Advisory Action, the Examiner changed his position and asserted that such "designer discretion particulars" are taught by Li at Column 12, Lines 27-34. In the following discussion, Applicant will show why both of these interpretations are clearly erroneous.

First, with regard to the assertion that the "physical design" of Li teaches the "designer discretion particulars", assuming the physical design and the drc rule of Li do correspond to "designer discretion particulars" and "determination rule," respectively, the Examiner's assertion regarding the "design result discretion means" is inconsistent because in that case the verification tool of Li **would verify if the "designer discretion particulars" meets each of the "determination rule."** As recited in claim 1, "design result determination means" is for determining whether a design result obtained by the automated design means satisfies the determination rule, while the design result is obtained by using the design requirement particulars, the designer discretion particulars, and the design rule.

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In view of these reasons, it is clear that the "physical design" of Li cannot teach the "designer discretion parameters" as required by the claims.

Second, with regard to the new assertion that the discussion at Column 12, Lines 27-34 teaches the "designer discretion particulars", Applicant submits that the discussion clearly cannot teach "designer discretion particulars **by discretion of the designer with respect to the design of the product**" for at least two reasons.

First, the discussion cited relates to "specif[ying] parameters . . .**which can be used in the technology file 202 to <u>translate the global design rule definition file into a non-native language format</u>**." (Li, Col. 12, Lns. 28-31). Applicant respectfully submits that **<u>translating the global design rule definition file into a non-native language format</u>** has **<u>absolutely nothing</u>** to do with a "automated design means for **<u>performing automated design using</u>**". This could only be as such if **the design result were the translated global design rule definition file and not the physical design.** This is nonsensical and clearly erroneous.

Second, even assuming that such translation had anything to do with the creation of the physical design, (which Applicant respectfully submits is incorrect), Applicant respectfully submits that the specified parameters would still fail to be taught or suggested as "**<u>by discretion of the designer <u>with respect to the design of the product</u></u>**" or even discretionary at all. Parameters for the translation of a definition file into a non-native language are not be discretionary. If these parameters were incorrectly specified, the CAD program would not function. As such, Applicant respectfully submits that the specification of these parameters is clearly not discretionary or "by discretion of the designer." Further, these parameters are clearly applicable on a global level. (i.e. used to translate the **<u>global design rule definition file</u>**). As

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such, Applicant respectfully submits that these parameters are not "by discretion" with respect to the "physical design" being designed by the automated design means.

In view of these reasons, it is clear that the parameters discussed in Column 12, Lines 27-34 cannot teach the "designer discretion parameters" as required by the claims.

As such, Applicant respectfully submits that, regardless of which interpretation is used, the reference clearly cannot be said to teach or suggest "**automated design means for performing automated design using** design requirement particulars with respect to a design of the product required by a customer or a designer, **designer discretion particulars by discretion of the designer with respect to the design of the product,** and the design rule necessary with respect to the design of the product.

Accordingly, Applicant submits that Li fails to disclose each and every element of the

claim. In view of the foregoing remarks, Applicant respectfully submits that the rejection of

independent claim 1, as well as dependant claims 2 and 7, should be withdrawn. Furthermore,

Applicant respectfully submits that independent claims 3 and 5 would not have been anticipated

by Li for similar reasons and requests that the withdrawal of the rejection to these claims too.

Finally, Applicant respectfully submits that claims 4, 6, 8 and 9 are patentable at least by virtue

of their dependence from claims 3 and 5 and respectfully requests the withdrawal of the rejection

to these claims as well.

Respectfully submitted,

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